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Attorney Docket No.: 2401.139.US

In re the PATENT application of

Kenneth M. Adams

Examiner: Kevin Thao Truong

Serial No.: 10/781,852

Group Art Unit: 3734

Filed: February 20, 2004

For: Surgical Elongate Blade Assembly with Interchangeable
Inner Member, Kit and Method Relating Thereto

MAIL STOP: AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith are the following documents for filing in the subject patent
application:

Request for Reconsideration; and
Return Receipt Postcard.

Respectfully submitted,

Karen M. Gerken
Karen M. Gerken
Registration No. 31,161

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: MAIL STOP: AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on May 14, 2008.

Ann L. Shebovsky
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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REQUEST FOR RECONSIDERATION

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

This communication is submitted in response to the Office Action dated March 17, 2008.

Claims 5-7 and 13-16 are pending in the subject patent application and stand finally rejected as being unpatentable over Krause et al in view of Sjostrom et al. The final rejection is believed to be improper, and reconsideration of the subject patent application is respectfully requested in view of the following remarks.

The method recited in independent claim 5 involves an individual inner member that is, during a surgical procedure on a patient, inserted interchangeably within first and second outer tubular members having different configurations and is rotated within

the first and second outer tubular members to treat tissue during the surgical procedure. Krause et al does not disclose an individual inner member intended to be interchangeably inserted within first and second outer tubular members having different configurations. An inner member and first and second outer tubular members capable of functioning in the manner necessary to carry out the claimed method can only be found in Krause et al through a strained interpretation of Krause et al's disclosure and through the use of impermissible hindsight made possible by Applicant's teachings alone. The Examiner refers to Krause et al as disclosing a first outer tubular member 12, 112 having a first configuration, an inner member 14, 114 rotatably disposed in the first outer member to treat tissue, removal of the inner member 14, 114 from the first outer member 12, 112 (relying in particular on column 9, lines 16-30 of Krause et al), and insertion of the inner member 120 in a second outer tubular member 12 having a second configuration different from the first configuration. First of all, column 9, lines 16-30 of Krause et al does not discuss removing an inner member from a first outer tubular member as asserted by the Examiner. Krause et al discusses in column 9, lines 16-30 the instrument 110 of Figs. 7a and 7b including outer tube 112 within which the inner tube 114 having flexible region 16 rotates. There is absolutely no discussion or inference whatsoever by Krause et al in this section of the written description of removing the inner member 14, 114 from the outer member 12, 112. Interpreting Krause et al as teaching removal of the inner member 14, 114 from the outer member 12, 112 based on column 9, lines 16-30 and Figs. 1, 7a and 7b requires the presumption that the inner member 114 of the instrument 110 is the same as the inner member 14 of the instrument 10. However, there is no factual basis for making such a

presumption when the teachings of Krause et al are considered for what they reasonably disclose without engaging in impermissible hindsight made possible from Applicant's invention. Krause et al does not reasonably disclose the inner member 114 as being the same as the inner member 14, but only that the inner member 114 has a flexible region 16 like that of inner member 14. Krause et al does not use the same reference number for inner members 14 and 114 but does use the same reference number 16 for the flexible regions of the inner members 14, 114. Krause et al's deliberate selection of different reference numerals for the inner members 14 and 114 demonstrates an intention that the inner members 14 and 114 not be construed to be the same. The inner member 114 of the instrument 110 can only be interpreted as being the inner member 14 of the instrument 12 by exceeding the reasonable metes and bounds of Krause et al's disclosure and by relying on impermissible hindsight.

The Examiner's reliance on Fig. 12 of Krause et al as disclosing insertion of the inner member in a second outer tubular member having a second configuration different from the first configuration of the first outer tubular member is believed to be entirely unfounded. Fig. 12 of Krause et al depicts the inner tube 120 disposed within the outer tube 12, and there is no doubt the inner tube 120 is intended by Krause et al to be completely different from the inner tubes 14, 114. Krause et al employs a different reference numeral for the inner tube 120 and it has a completely different flexible region 122 than the flexible region 16 of the inner tubes 14 and 114. The Examiner's interpretation of Krause et al is clearly illogical because it is based on equating the inner tubes 14 and 114 to the recited inner member and then equating the inner tube 120 to the same recited inner member. There are absolutely no teachings or

suggestions whatsoever by Krause et al of an individual inner member that is interchangeably inserted within first and second outer tubular members having different configurations and is rotated within the first and second outer tubular members to treat tissue, much less during a single surgical procedure performed on a patient.

Sjostrom et al fails to rectify the aforementioned deficiencies of Krause et al and further fails to disclose the teachings for which it is relied on by the Examiner. Sjostrom et al pertains to different surgical devices 12, 14, 16 removably attachable to a motorized handpiece, and a plurality of different rotary tips are interchangeably attachable to each surgical device. The rotary tips are described by Sjostrom et al as "blade assemblies", particularly the Shaver, Cutter and Trimmer Blade Assemblies and the Abrader and Full Radius Synovectomy Blade Assemblies manufactured by Dyonics, Inc. Rotary tips of this type are conventionally known to include a blade or inner member rotatably disposed within an outer member. Fig. 1 of Sjostrom et al shows each of the rotary tips 25-31 to have an outer member and an inner member or blade rotatable within the outer member. Inner and outer members are seen at the distal ends of the rotary tips in Fig. 1 and also by the inner and outer member hubs at the proximal ends of the rotary tips in Fig. 1. The written description of Sjostrom et al is also consistent with each rotary tip being made up of an outer member and a rotatable inner blade (column 4, lines 50-51; column 5, lines 60-61). Although Sjostrom et al discloses the rotary tips 25-27 being interchangeably attachable to the surgical device 12, the rotary tips 28 and 29 being interchangeably attachable to the surgical device 14, and the rotary tips 30 and 31 being interchangeably attachable to the surgical device 16, there are absolutely no teachings or suggestions whatsoever by Sjostrom et al of

any inner member or blade of the rotary tips being interchangeably insertable in first and second outer tubular members having different configurations. The Examiner's statement that "Sjostrom et al teaches that it is known in the art to have the inner member removed from the first outer member prior to inserting the inner member in other outer member during surgical procedure" finds no support whatsoever in the disclosure of Sjostrom et al and is believed to be clearly in error. In order to clarify the issues in the event of an appeal, it is respectfully requested that the Examiner identify, in the next communication, where in Sjostrom et al it is taught to remove an inner member from a first outer member prior to inserting it in another outer member during a surgical procedure. It is maintained that there are no teachings or suggestions in Sjostrom et al from which Krause et al could be modified to arrive at the claimed invention. Accordingly, independent claim 5 is submitted to be clearly patentable over Krause et al in view of Sjostrom et al and should be allowed along with its dependent claims 6, 7 and 13-16.

In light of the foregoing, the subject patent application is believed to be in condition for allowance with claims 5-7 and 13-16. Action in conformance therewith is courteously solicited. Should any issues in the subject application remain unresolved, the Examiner is encouraged to contact the undersigned attorney.

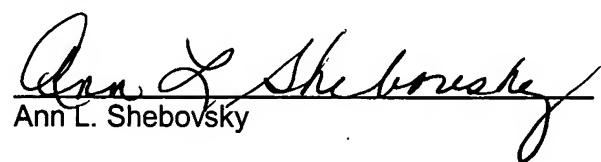
Respectfully submitted,



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